

**REMARKS**

Claims 1-211 are indicated as pending, however Applicant notes that claims 171-176 in fact are not pending because they never existed as a result of an inadvertent slip in numbering. Claims 160-163, 167, 177, 178, 181, 183, 188, 191-193, 196, 198, 199, 203, 207, 208, and 211 are withdrawn from consideration (despite traversal of requirement by Applicant). Claims 1-159, 164-166, 168-170, 179, 180, 182, 184, 185-187, 189, 190, 194, 195, 197, 200-202, 204-206, 209, and 210 presently stand rejected. Claims 1-4, 6-10, 12, 14-15, 20-29, 32, 38-40, 45, 58, 64, 133-138, 149, 159, 164-165, 169-170, 179, 182, 185-186, 190, 194, 197, 200-201, 205-206, and 209 are amended here. The Examiner makes no reference to the status of claims 184, 197, 204-205 in the summary page and the body of the office action. Applicant requests clarification of the status of these claims.

Applicant is submitting a Request for Continued Consideration ("RCE") with this Preliminary Amendment. By this Preliminary Amendment, Applicant has amended the scope of all the claims and demonstrates reasons why the claims pending here are distinct from the asserted art. In view of the amendments and the arguments below, Applicant respectfully requests the Examiner to reconsider all the outstanding rejections and to withdraw them.

***35 U.S.C. § 103 Rejections***

In paragraph 2 of the office action, the Examiner has variously rejected claims 1-159, 164-166, 168-170, 179, 180, 182, 185-187, 189, 190, 194, 195, 197, 200-202, 206, 209, and 210 under 35 U.S.C. §103(a) as being unpatentable over De Lapa et al. (U.S. Patent No. 5,822,735).

With respect to De Lapa et al., the Examiner indicates (set forth in italics) the following rationale for rejecting the pending claims:

*De Lapa teaches a method of automatically preparing a communication pertaining to a product for an entity (Abstract). (1)Automatically determining whether to offer a product to said entity (figure 6); (2) if it is determined to offer a product to said entity, then using decision information to automatically determine variable information, the variable information in the communication for said entity (see Figures 2 and 6); (3) and automatically generating the communication, the communication including an offering to said entity for a product, the communication having communication format, wherein said communication format comprises at least one portion that accommodates the variable information, the generating step including incorporating the variable information into said at least one portion of the communication, wherein the variable information is related to said offering, and wherein the content of said offering in said communication includes variable information such that said offering comprises said variable information in said offering at least partially identifies the product being offered to said entity (see Figure 2).*

*De Lapa teaches that said variable information may vary among persons being offered said product or said service such that offers of said product to said persons may vary from person to person (i.e. **assigning different coupon values** to non-customer versus regular customers in order to further induce the customer to the retail store)(in De Lapa, col. 5, lines 14-17 and col. 20, lines 9-12).*

*De Lapa, col. 5, lines 14-17 and col. 20, lines 9-12*

*This may be accomplished, for example, by assigning higher coupon values to non-customers of the participating retailer than to regular established customers, in order to further induce the consumer to the retailer's store.*

*DeLapa teaches the steps being performed using data processing devices and within an automated process (i.e. the steps of determining and generating are performed via a computerized system)(see Figure 4).*

*With respect to the newly added feature of the product/service set includes at least one or more product or services that is at least considered for offering to each entity in said entity set who is being considered for an offer (i.e. the coupon can be assigned to more than one prior members who is eligible to receive the coupon)(col. 14, lines 33-40)*

De Lapa, col. 14, lines 33-40

The routine is initiated (110) by selecting (112) the first record of a member. The Current Coupon Data Structure is accessed to select (114) the first coupon authorized for that mailing. It is then determined at (116) whether that coupon has been exhausted as a result of assignment to prior members. Because this is the first member, it will be determined at 116 that the coupon is not exhausted. It is then determined at (118) whether this coupon is mandatory.

*De Lapa does not specifically teach that the offer is for a financial product or financial service. Official notice is taken that it is old and well known to offer financial products or financial services to customers. For example, bank customers are often offer additional services such as car loans, vacation loans, mortgages loans in order for the banks to provide additional services or products that might be needed by the customers.*

*With respect to claims 2-11, 65-73 De Lapa further teaches storing said data in one or more databases and collecting additional data from one or more sources, and updating said one or more databases with said additional data accessible via modem (col. col. 7, lines 61-67).*

De Lapa, col. col. 7, lines 61-67

Captured data files in data base 176 are uploaded (78) to data base 92 and, in turn, uploaded (80) via modem 64a and 64b in order to update (82) master data base 31. In-store system 69 may, optionally, include a retailer host computer 89 for the management of the data processing functions of the store and other functions not related to focused coupon system 15.

*Claims 12-52, 74-115, 132-138, 142, 170, 180 further recite selecting the format for the communication and said selected delivering medium. Official notice is taken that it is well known to select different mediums in which to deliver information to users. For example, some users prefer e-mail to regular mail and this is taken into account in order to select the medium in which to deliver information.*

*With respect to claims 59-63, 122-126, 139-140, 205-206 the claims further recite that the services relate to mortgage loan, insurance. Official notice is taken that mortgages loans and insurance related products are well known products or services offer to clients in order to meet client's needs. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the services or products to be related to mortgage loans and insurance in order to obtain the above mentioned advantages.*

*With respect to claim 141, De Lapa further teaches providing said communication and reply means to said entity electronically (Figure 5).*

*With respect to claim 149, 152 De Lapa further teaches selecting a first and second delivering medium that will be used to deliver subsequent communication pertaining to said offer (Figures 1 and 5).*

### ***Criteria Governing 35 U.S.C. Section 103 Rejections***

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot **change the principle of operation of the primary reference or render the reference inoperable for its intended purpose.** MPEP § 2143.03.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. \_\_\_\_2007)) to be “expansive and flexible” and “functional.” However, the standard is **not** controlling, rather, the various noted factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in *KSR* enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The

Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in *KSR* stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art.

“Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by

finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in KSR has also stated that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

When considering the question of obviousness, further evidence of nonobviousness may also be considered, such as, for example, commercial success of the subject matter. *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 893).

### ***Discussion of the Differences Between Applicant's Claims and De Lapa***

Applicant respectfully submits that his inventive method and system is completely distinct from De Lapa in its intended purpose and operation. At least three reasons are indicated below. Independent claims 1, 64, 159, 182 and 197 are amended to emphasize these distinctions.

The other remaining claims are amended to address inconsistencies and to otherwise clarify them.

**1. De Lapa does not teach an offering of a financial product or service, it teaches a mechanism that offers a “discount” on the price of some tangible product**

The claims at issue here are directed to an invention that is completely different from De Lapa. De Lapa is directed to “coupons,” which serve as a “discount” on the price of a tangible product when a purchase is made (see column 3, lines 15-18, column 4, lines 39-42, and column 6, lines 43-48 in De Lapa, and the text copied below). That “discount” cannot be characterized as a financial product itself (see column 4, lines 37-39 and column 6, lines 43-48 in De Lapa and the text copied below). Nor can that “discount” be characterized as an offering of a financial product or service. At best, it is an offering of a reduction on the price of a product to which the coupon applies.

De Lapa, column 3, lines 15-18

The coupon identification will specify at least the discount value of the coupon and may additionally include a transaction to which the discount value is to apply.

De Lapa, column 4, lines 39-42

Such discounts are typically provided by the manufacturer in terms of a total discount which may be distributed among a number of coupons or a given discount per coupon.

De Lapa, column 6, lines 43-48

It is not necessary that coupon 48 pertain only to a particular product. Alternatively, it could apply to a purchase from the participating retailer above a set amount, as indicated at 50' or apply to purchases at a particular department, such as the delicatessen department, of the retailer (not shown).

De Lapa, column 4, lines 37-39

The system may distribute coupons, whose value have been provided by various manufacturers, in order to promote the products of that manufacturer.

2. **De Lapa does not teach using variable information specific to the entity for whom the product is created**

In De Lapa, the “variable” information on the “coupon” is specific to the entity only to the extent of indicating the identity of the entity (see column 9, line 67-column 10, line 4 and Figure 2 in De Lapa and the text copied below).

De Lapa, column 9, line 67-column 10, line 4

The master data base will capture for each coupon 48 used by the consumer, data identifying the coupon I.D., namely product identification, coupon value, expiration date, as well as the identification code, or household code of the consumer.

Other than that, any information that is variable pertains to the discount, such as the degree or extent of “discount” offered by a manufacturer on the pricing of a product or the expiration date of the discount offering etc (see column 16, lines 32-36, 52-62 and Figure 2 in De Lapa and the text copied below).

De Lapa, column 16, lines 32-36, 52-62

The system identifier establishes whether the bar code is for (A) a standard product of the type sold by established manufacturers, (B) a standard coupon of the type typically issued by manufactures of products, or (C) an in-store custom application.

Once the record is retrieved for a scanned code, the master terminal tallies the price to the purchase total, if the code is for a product being purchased. If the code is for a coupon, the master terminal will give a credit against the purchase. The master terminal may optionally verify that a product corresponding to that of the coupon has been purchased as a condition to giving a credit against the purchase. Typically, a transaction record is generated



and uploaded to the store management computer in order to adjust the inventory records for the product and for statistical analysis and the like.

None of these parameters are “variable” information specific to the entity for whom a financial product or service is being created as in Applicant’s method and system. The Examiner’s attention is pointed to the following text in De Lapa, by way of an example of this distinction (see column 3, lines 13-19 in De Lapa and text copied below):

De Lapa, column 3, lines 13-19

The coupons thus generated will be variable as to at least the identity of the consumer and a coupon identification, both of which are encoded on the coupon in machine readable form. The coupon identification will specify at least the discount value of the coupon and may additionally include a transaction to which the discount value is to apply.

**3. De Lapa does not teach creating a financial product or service or both using the identity of the entity**

In De Lapa, the identity of the person, to the extent it is utilized, is only for the purpose of either (1) delivering coupons to offer a “discount” to a particular consumer or (2) matching records to determine when the coupon delivered to the consumer have been redeemed (see column 3 lines 23-30 and column 18 lines 13-16). The actual identity of the person receiving and redeeming the coupon (i.e. purchasing the product) is never verified (see column 18 lines 13-16).

De Lapa, column 3 lines 23-30

A method according to another aspect of the invention includes identifying a particular consumer, printing a packet of coupons for the identified consumer, transmitting the packet to the consumer, identifying which coupons in the packet the consumer uses and printing another packet of coupons for that consumer, with at least

one coupon selected as a function of the coupons the consumer used. Other consumption related information pertaining to the consumer may be combined with the history of coupon use in order to select coupons to transmit to the consumer.

De Lapa, column 18 lines 13-16

When that one record is retrieved, the in-store master terminal can credit the purchaser of the product, keep appropriate transaction records and the like. The in-store system 69 does not become apprised of the coupon program member corresponding to the scanned code bearing their household I.D.

The identity is not used for the purpose of creating a financial product or service specific to the entity for whom it is intended (see e.g., column 6, lines 31-34 and column 18, lines 13-16). De Lapa's coupon offers a discount toward a future purchase of a tangible product (identified in machine readable code).

De Lapa, column 6, lines 31-34

As will be set forth in more detail below, machine readable code 56 is encoded to allow access to the identity of the product or purchase criterion, the expiration date of the coupon and the discount amount.

**Conclusion**

Accordingly, Applicant submits that claims 1, 64, 159, 182 and 197, as amended above, to emphasize these distinctions, clearly distinguish over De Lapa. Reconsideration and allowance of these claims is most earnestly requested. The remaining claims depend from the independent claims and are distinct at least for the reasons by which the independent claims are distinct. Moreover, other reasons that distinguish these claims are indicated in the prior responses, the content of which is incorporated herein by reference.

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In addition, the undersigned respectfully requests a personal interview with the Examiner to expedite conclusion of this application.

Respectfully submitted,

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